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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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06/11/2003

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EXAMINER

MORRIS, PATRICIA L

ART UNIT	PAPER NUMBER
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1625

DATE MAILED: 06/11/2003

17

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/470,563

Applicant(s)

Fischer et al

Examiner

P. Morris

Group Art Unit

1625

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 10-22-2002
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 3-6, 10-25 and 29-35 is/are pending in the application.
- Of the above claim(s) 6, 19 and 21-25 is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 5, 29, 30 and 32-34 is/are rejected.
- ☒ Claim(s) 3, 4, 10-20, 31 and 35 is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ Received in Application No. (Series Code/Serial Number) _____.
- ☐ Received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

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DETAILED ACTION

Claims 3-5, 10, 12-20 and 29-35 are under consideration in this application.

Claims 6, 19 and 21-25 are held withdrawn from consideration as being drawn to nonelected subject matter 37 CFR 1.142(b).

Election/Restriction

Applicant's election with traverse of Group I and the species of example 79 in Paper No. 15, filed October 22, 2002 is acknowledged. The traversal is on the grounds that the compounds all share a common structural core. This is not found persuasive for the reasons set forth in Paper no. 12. Applicants' claims encompass all heterocyclic chemistry. Further, applicants has failed to advance any cogent reasons as to why the compounds are not patentably distinct.

"A Markush-type claim is directed to "independent and distinct inventions", if two or more of its members are so unrelated and diverse that a prior art reference anticipating the claim with respect to one of the members would not render the claim obvious under 35 U.S.C. 103 with respect to the other member(s)". In re Weber, 198 USPQ 330, footnote 3.

It is too burdensome for the examiner to search all of the previously noted searches in their respective, completely divergent, areas for the non-elected subject matter, as well, in the limited time provided to search one invention. The staggering arrangement of possibilities does permit classification or examination of the claimed compounds.

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This application has been examined with respect to the elected compound and expanded to include compounds wherein R^2 , R^7 , R^8 represent non-heterocyclic groups and R^1 , R^{12} - R^{14} and X as set forth in claim 29, exclusively.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 29 and 32-34 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The terms alkyl, alkenyl, alkynyl, aryl etc., alone or in a combined term, in the various groups, are not limited from infinity in their carbon size in claims 29 and 32-34. Very large hydrocarbons would be waxes, which would make them unacceptable for herbicidal preparations.

Aryl could be read as aromatic. Some aromatic groups are heterocyclic. Therefore, the indefiniteness of claims 29, 33 and 34 causes overlap.

Applicants claim all aryl radicals in R^6 , R^7 , R^{13} and R^{14} . Applicants' exemplification cannot be seen to provide adequate representative support for such a claim.

There are no carbon limits on aryl in the claims.

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The definition of aryl is varied, note the footnotes on pages 134 USPQ 301-304 of In re Sus, for multiple varied definitions of aryl.

Therefore, applicants need to indicate in the claims what they intend by aryl.

All aryl radicals are not supported in the specification, yet they are claimed here. Applicants could resolve this point in the claim by indicating aryl is phenyl, naphthyl, or indicate a carbocyclic aryl of 6 to 10 carbon atoms.

A Markush listing of specific intended, producible rings for aryl is suggested in claims 29, 33 and 34.

The expression optionally substituted is employed with considerable abandon throughout claims 29 and 32-34 with no indication given as to what the substituents really are.

One should be able, from a reading of the claims, determine what that claim does or does not encompass.

Why? Because that claim precludes others from making, using, or selling that compound for 20 years. Therefore, one must know what compound is being claimed.

The unknown substituents aryl groups are so broad that they cause the claim to have a potential scope of protection beyond that which is justified by the specification disclosure.

The written description is considered inadequate here in the specification. Conception of the intended substituents and aryl groups should not be the role of the reader. Applicants should, in return for a 20 year monopoly, be disclosing to the public that which they know as an actual demonstrated fact. The disclosure should not be merely an invitation to experiment. This is a 35

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USC 112, first paragraph. If you (the public) find that it works, I claim it, is not a proper basis of patentability. In re Kirk, 153 USPQ 48, at page 53.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 5 and 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 30, the phrase "in particular" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

The term locus is misspelled in claim 5.

The claims measure the invention. United Carbon Co. V. Binney & Smith Co., 55 USPQ 381 at 384, col. 1, end of 1st paragraph, Supreme Court of the United States (1942).

The U.S. Court of Claims held to this standard in Lockheed Aircraft Corp. v. United States, 193 USPQ 449, "Claims measure invention and resolution of invention must be based on what is claimed".

The C.C.P.A. in 1978 held "that invention is the subject matter defined by the claims submitted by the applicant. We have consistently held that no applicant should have limitations of the specification read into a claim where no express statement of the limitation is included in the claim": In re Priest, 199 USPQ 11, at 15.

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Claim 15 is objected to as being too close to the top margin.

Specification

The abstract of the disclosure is objected to because the abstract is too long. Correction is required. See MPEP § 608.01(b).

Priority

Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification or in an application data sheet (37 CFR 1.78(a)(2) and (a)(5)).

This application filed under former 37 CFR 1.60 lacks the necessary reference to the prior applications 07/618,355 and 07/435,898. Also, the current status of all nonprovisional parent applications referenced should be included.

Applicants are requested to update the status of the parent applications 08/148,094 and 07/918,895. Cooperation herein is appreciated.

Allowable Subject Matter

Claims 29 and 32-34 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112 set forth in this Office action and if rewritten directed to the subject matter indicated as being examinable, supra.

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Claims 5 and 30 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112 set forth in this Office action and to include all of the limitations of the base claim and any intervening claims and if rewritten directly solely to the elected compounds.

Claims 3, 4, 10-20 and 31 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims and directed to the elected subject matter.

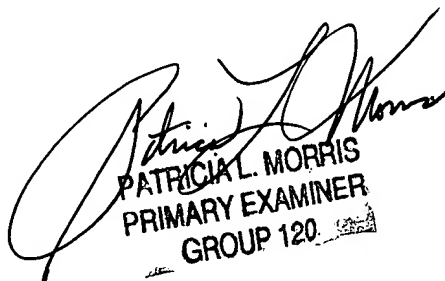
Claim 35 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ms. Morris whose telephone number is (703) 308-4533.

plm

June 9, 2003


PATRICIA L. MORRIS
PRIMARY EXAMINER
GROUP 120